REMARKS

Responsive to the Official Action of April 20, 2004, it is respectfully requested that the above-identified application be re-examined and reconsidered to 37 C.F.R. Section 1.112, and in light of the remarks that follow.

By the present amendment, claims 26, 28, 29 and 36 to 38 have been amended to clarify the present invention. Support for the amendment of claim 36 appears at least on page 14 of the specification as filed. Claims 53 and 54 have been added. Support for these two new claims appears at least on page 13 of the specification. Applicants submit that no new matter ahs been added via this amendment.

Claims 26 to 29, 31, 41, 43, 46 and 50 to 51 have been rejected under 35 U.S.C. §102(a) as allegedly being anticipated by COUTURIER et al. This rejection is respectfully traversed.

In imposing this rejection, the Office Action deems that the thymidine kinase promoter taught by COUTURIER et al. promoter would compromise at least one dinucleotide sequence present in at least one PLA2 gene and that this reference also discloses a PPRA-binding element. The Office Action concludes that COUTURIER et al. teach a PPAR response element linked to a "heterologous sequence" from a PLA2 gene.

However, Claim 26 has been amended such that the PLA2s gene is SEQ ID NO. 5. As COUTURIER et al. fail to disclose or suggest this particular sequence, Applicants believe that

COUTURIER et al. fail to anticipate or render obvious the claimed invention.

In view of the above, withdrawal of this rejection is respectfully requested.

Claims 26 to 29, 41, 43, 46 and 50 to 51 have been rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Evans et al. (U.S. Patent No. 6,413,994). This rejection is respectfully traversed.

As stated above, Claim 26 has been amended to recite that PLA2 gene is SEQ ID NO. 5. Evans et al. fail to teach this particular sequence. As a result, claims are neither anticipated nor obvious in view of this reference.

In view of the above, withdrawal of this rejection is respectfully requested.

Claims 26, 29, 41, 43, 46 and 50 to 51 have been rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Juge-Aubry et al. This rejection is respectfully traversed.

In imposing this rejection, the Office Action purports that Juge-Aubry et al. disclose in Figures 2 and 5, a 5′ flanking sequence of DR1 from HMG linked to the core DR1 sequence of ARE6. As a result, the Office Action concludes that this construct would constitute a hybrid promoter.

However, Applicants respectfully disagree with the Office Action conclusion. Juge-Aubry et al. disclose the DNA binding properties of PPAR subtypes on various natural peroxisome

proliferation response elements. It was concluded that the degree of binding does not depend on the core DR1 sequence, which is relatively conserved, but correlates with the number of identities of the 5' - flanking nucleotides with respect to the consensus element. This reference fails to teach that these constructs can be used as a hybrid promoter. Rather, they were only used in binding experiments (Figure 2) or as probes (Figure 5).

Moreover, Applicants note that Juge-Aubry et al. fails to disclose or suggest a hybrid promoter with the PPAR element and a PLA2 gene of SEQ ID NO.5.

Therefore, Juge-Aurby et al. fail to disclose or suggest the claimed invention. Withdrawal of this rejection is thus respectfully requested.

Claims 39 and 45 have been rejected under 35 U.S.C. § 103(a) as allegedly being obvious in view of Juge-Aubry et al. For the following reasons, this rejection is respectfully traversed.

Claim 39 relates to specific sequences of SEQ ID Nos. 1 to 5, while claim 45 relates to a composition containing these sequences. It should be noted that none of these specific sequences are disclosed in Juge-Aubry et al. Indeed, none of the sequences described in Figure 2 contain the CAAAAC T motif recited in the claimed sequences.

Nor does Juge-Aubry et al. suggest to the skilled artisan to alter or modify the sequences in such a way to arraive at the presently claimed invention. Indeed, this publication does not even suggest that those sequences described in Figure 2 can be used as a hybrid promoter.

At this time, the Examiner's attention is respectfully directed to the Federal Courts decision in Sibia Neurosciences Inc. v/ Cadus Pharmaceutical Corp. 55 USPQ 2d 1927 (Fed. Cir. 2000) wherein the court states:

"To establish a prima facie case of obviousness, the prior art reference (or references when combined) much teach or suggest all the claim limitations MPER § 2142. In addition, if a reference needs to be modified to achieve the claimed invention there must be a showing of a suggestion or motivation to modify the teachings of that reference to the claimed invention in order to support the obviousness conclusion (emphasis added)."

Thus, without any suggestion in Juge-Aubry et al. to modify their sequences disclosed in Figure 2 to arrive at the present invention, this rejection cannot be maintained. As a result, withdrawal of this rejection is respectfully requested.

Claims 26 to 29, 31, 35 to 38, 41 to 44, 46, 47 and 50 to 52 have been rejected under 35 U.S.C. §112, second paragraph as being indefinite. These claims have been amended, which should render this rejection now moot. More specifically,

"heterologous" has been deleted from claim 26; and claims 37 and 38 have been amended such that there's antecedent basis.

In view of the above, withdrawal of this rejection is respectfully requested.

From the foregoing, favorable action in the form of a Notice of Allowance is respectfully requested and such action is earnestly solicited.

Please charge the fee of $43.00 for the extra independent claim added herewith, to Deposit Account No. 25-0120.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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